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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,101	08/20/2001	Claude Lambert	159.1.334 A	7127

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WATOV & KIPNES, P.C.
P.O. Box 247
Princeton Junction, NJ 08550

EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,101

Applicant(s)

LAMBERT ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royer ('991) in view of Ehrhart et al. ('157).

Royer discloses a document (20) comprising a substrate; a play area comprising an encoded game data portion (22) on the substrate; a non-game data region (area other than game data portion on surface 24) and at least one scratch-off layer (26) over the encoded game data portion.

Royer discloses the claimed invention except for the particular layers of the encoded game data portion as claimed.

Ehrhart et al. disclose methods for processing security documents comprising a game ticket (202) having a first indicia icon layer (226) forming the indicia patterns (223) covered by scratch-off material and a second translucent, printable varnish layer (238 – release layer); wherein both layers are located beneath the scratch-off material (211) (as seen in figure 2-5 and col. 7, lines 5-15). The first and second layers together define a game data region (226) and a non-game data region (228) with the game data region comprising an encoded pattern of symbols (223). The first and second layers are constructed of different materials (as evidenced by the lines of element 226 and the

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omission of lines of element 228) and would, therefore, exhibit, different reflectance values. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Royer's invention by providing the encoded game data portion with two different layers having two different reflectance values, as taught by Ehrhart, to enhance the security of the document deterring the possibility of forgery.

Regarding claims 2, 5, 7, 18, 20, 22 and 27, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a desired value for the reflectance (e.g. the value of the second reflectance less than the value of the first reflectance), since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 3, Royer, as modified by Ehrhart et al., disclose that various colors and shades of colors are seen in white light when illuminated by a narrow band of illumination source (red light - see col. 12, lines 17-20 and 59-63).

Regarding claims 4, 6, 19 and 21, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide any desired range for the reflectance value, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 8 and 9, Royer, as modified by Ehrhart et al., disclose the encoded pattern of symbols being present in the game data region and the non-game data region (as seen in figures 2-4 of Royer and col. 7, lines 5-10 of Ehrhart et al.).

Regarding claim 10, Royer, as modified by Ehrhart et al., disclose the encoded pattern of symbols appearing in less than the entire game data region or non-game data region (as seen in figure 3 of Royer and figure 2-5 of Ehrhart et al.).

Regarding claim 11, it would have been obvious to locate the encoded pattern of symbols in any desired arrangement, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, applicant has failed to disclose that the location of the encoded pattern of symbols is critical to the invention.

Regarding claims 14-17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second encoded pattern, a second layer with non-game data, at least one additional layer printed over the at least one scratch-off layer, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 28, the document is a lottery ticket (see Royer col. 2, lines 13-15).

Regarding claim 29-39, the method of detecting tampering of a document and producing a tamper resistant document is inherently disclosed in the above rejections.

Response to Arguments

3. Applicant's arguments filed September 15, 2003 have been fully considered but they are not persuasive.

Applicant argues that Ehrhart et al. fail to teach or suggest the varnish layer 228 being used for an anti-fraud system in a manner claimed in the present application. The examiner disagrees. Ehrhart et al. disclose that the intent of the invention is to provide an improved design for lottery game tickets that prevent peeking into the win/loss status of the game and easily detects the fraud of peeking into the win/loss status of a game by way of removing and replacing a section of a scratch-off material (see col. 2, lines 54-60). The game ticket 202 of Ehrhart et al. includes a substrate 218 with several layers of material layered over the substrate. A play area 210 is formed on the substrate. Formed directly on the substrate in the play area is a first ink layer 226 which forms the indicia which will be covered by scratch-off material. Indicia patterns of this layer comprise variable data indicia icons 223. A second, translucent material layer 228 of printable varnish protects the indicia icons of the indicia icon layer 226 so that the indicia icons are not removed when scratch-off layers of the game ticket are removed (see in col. 7, lines 5-15). Therefore, the varnish layer 228 of Ehrhart et al. not only provides protection for the indicia printed on the substrate, but also maintains the integrity of the indicia on the substrate. The examiner maintains that Ehrhart et al. does disclose a layer that can be used for an anti-fraud system in a manner claimed in the present application. The examiner further maintains that the combination of Ehrhart et al. with Royer does lead one of ordinary skill in the art to the claimed invention for the reasons as set forth above.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

November 5, 2003

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER